

REMARKS:

Claims 1-37 are currently pending in the subject Application.

Claims 1-37 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,991,739 to Cupps, et al. ("Cupps") in view of U.S. Patent No. 4,971,406 to Hanson ("Hanson") and U.S. Patent No. 5,895,454 to Harrington ("Harrington"), and further in view of U.S. Patent No. 6,657,702 to Chui et al. ("Chui"). Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of U.S. Patent No. 4,797,818 to Cotter ("Cotter").

A Final Office Action in the subject Application was mailed to the undersigned on 4 April 2006, which provides for a response period ending 4 July 2006. The Applicant filed an Amendment After Final on 31 May 2006, within two (2) months of the date of the Final Office Action. An Advisory Action was mailed to the undersigned on 19 June 2006. The Advisory Action stated that the proposed Amendments filed on 31 May 2006 do not place the application in condition for allowance. (19 June 2006 Advisory Action, Page 2). The Applicant respectfully disagrees and further respectfully reiterates here the arguments set forth in the Amendment After Final filed on 31 May 2006, as if fully set forth herein.

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-37 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed.

The Office Action alleges that maximum delivery time and the indication of importance is considered new based on the usage of the word "or" on page 9, line 2 of the Specification. This allegation is respectfully traversed.

MPEP 2163 provides guidelines for determining whether claims comply with the written description requirement of 35 U.S.C. § 112, first paragraph. MPEP 2163(III)(A) provides that the Examiner bears the initial burden of establishing that claims fail to comply with the written description requirement:

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. **The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.** *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

(Emphasis added). Thus, failure to comply with the written description requirement must first be established by the Examiner, and the showing must be made by a preponderance of the evidence. MPEP 2163(III)(A) then explains that a proper showing must include express findings of fact that establish reasons why one skilled in the art would not have recognized that the inventor possessed the claimed invention:

In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

- (A) Identify the claim limitation at issue; and
- (B) Establish a *prima facie* case by providing **reasons why a person skilled in the art at the time the application was filed would not have recognized** that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

(Emphasis added). It should also be noted that the standard for compliance with the written description requirement involves the person of ordinary skill in the art, and what such a person would understand based on the written description:

The fundamental factual inquiry is whether the specification conveys with reasonable clarity **to those skilled in the art** that, as of the filing date

sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117.

MPEP 2163 (emphasis added). As pointed out in MPEP 2163, “**there is no *in haec verba* requirement.**” (emphasis added).

Thus, the Examiner bears the initial burden of establishing a *prima facie* case of failure to comply with the written description requirement, and in order to do so the Examiner must establish, by a preponderance of the evidence, reasons why one of ordinary skill in the art would not have recognized from the written description that the inventor was in possession of the claimed invention at the time the application was filed. It is respectfully submitted that this burden has not been met in the present case.

Applicant respectfully directs the Examiner’s attention to page 8, lines 23-28 of the Specification, which states:

Customer preference information for a customer 12 may include any information relating to the personal preferences of the customer 12. For example, in one embodiment, the customer preference information for customer 12 may include maximum and/or minimum price preferences, maximum delivery time preferences, and restaurant rating preferences of the customer 12. A particular preference of a customer 12 may be represented in any appropriate manner.

Thus, ***the Specification provides clear and explicit support for a combinations of types of personal preferences.*** Thus, there is no preponderance of evidence to establish that the present claims fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

In light of the discussion above, it is respectfully requested that the rejection of claims 1-37 under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of *Chui*. Claims 12, 22,

and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of *Cotter*.

The Applicant respectfully submits that *Cupps*, *Hanson*, *Harrington*, or *Chui*, either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 1-11, 13-21, 23-34, 36, and 37. The Applicant further respectfully submits that *Cupps*, *Hanson*, *Harrington*, or *Cotter*, either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 12, 22, and 35. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of claims 1-37 under 35 U.S.C. § 103(a) over the proposed combination of *Cupps*, *Hanson*, *Harrington*, *Chui*, and *Cotter*, either individually or in combination.

The Proposed *Cupps-Hanson-Harrington-Chui* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant Claims

For example, with respect to independent claim 1, this claim recites:

A system for brokering food order transactions among a plurality of unaffiliated sellers, comprising:

one or more databases containing:

delivery information associated with each of a plurality of buyers including a maximum delivery time preference of at least one of the plurality of buyers and an indication of how important the delivery time is to the at least one of the plurality of buyers;

substantially real-time availability information identifying particular food items available from each of a plurality of unaffiliated sellers;

pricing information for the particular food items available from each unaffiliated seller; and

delivery information for each unaffiliated seller comprising a delivery area for the unaffiliated seller and substantially real-time delivery time information for the unaffiliated seller based at least in part on a current order backlog for the unaffiliated seller; and

a food order transaction broker operable to:

receive a request for at least one particular food item from a buyer;

generate a list of one or more unaffiliated sellers of the requested particular food item according to a comparison of the requested particular food item with the substantially real-time availability information for each unaffiliated seller and a comparison of the delivery information for the buyer with the delivery area of each unaffiliated seller, the list

reflecting the pricing information for the requested particular food item for each listed unaffiliated seller, and the substantially real-time delivery time information for each listed unaffiliated seller; and

initiate a food order transaction concerning the requested particular food item with a particular listed unaffiliated seller selected from the list.

Independent claims 13, 23, and 24 recite similar limitations. *Cupps, Hanson, Harrington*, or *Chui* fail to disclose each and every limitation of independent claims 1, 13, 23, and 24.

Specifically, with respect to claim 1 (as well as claims 2-12, which depend from claim 1), this claim recites a system for brokering food order transactions comprising one or more databases. Claim 1 has been amended to further recite that one or more of the databases contain “delivery information associated with each of a plurality of buyers including a maximum delivery time preference of at least one of the plurality of buyers and *an indication of how important the delivery time is to the at least one of the plurality of buyers.*”

The Office Action acknowledges that Cupps, Hanson, and Harrington each fails to disclose or suggest a database that includes such delivery time preference and importance information for buyers. However, the Office Action alleges that this limitation is taught by Chui. This allegation is respectfully traversed. The Office Action points to item 240 in Figure 2D in support of this allegation, and reasons that the selection of a mode of delivery constitutes an indication of importance of delivery time. However, it is respectfully pointed out that the indication of mode of delivery shown in Figure 2D is a step in a check-out process (See Chui, col. 10, lines 13-15). Thus, solely for the sake of argument, assuming that selection of a mode of delivery constitutes an indication of importance of delivery time (although this point is not conceded), Chui would still fail to disclose or suggest storing such information as a buyer’s preference information. Thus, the proposed combination of Cupps, Hanson, Harrington, and Chui fails to disclose or suggest all of the limitations of claim 1.

Accordingly, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claim 1, or claims 2-12 depending from claim 1.

Attention is also drawn to claim 2, which depends from claim 1. Claim 2 recites “the indication of how important the delivery time is to the buyer includes at least one of an indication that delivery time is very important, an indication that delivery time is important, and an indication that delivery time is unimportant.” As pointed out above, the proposed combination of Cupps, Hanson, Harrington, and Chui fails to disclose or suggest the storage of delivery time importance preferences for buyers. It follows that the proposed combination of Cupps, Hanson, Harrington, and Chui likewise fails to disclose or suggest the more specific limitations in claim 2 involving storing an indication that delivery time is very important, important, or unimportant. For at least this additional reason, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claim 2.

Attention is further drawn to claim 3, which depends from claim 1. Claim 3 recites “the maximum delivery time preference is obtained from the buyer while the buyer is registering as a new user of the system.” The proposed combination of Cupps, Hanson, Harrington, and Chui fails to disclose or suggest storing a maximum delivery time preference obtained from a buyer during registration as a new user of the system. For at least this additional reason, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claim 3.

With respect to independent claims 13, 23, and 24, each of these claims includes limitations similar to those discussed above in connection with claim 1. Therefore, the comments presented above in connection with claim 1 apply equally to claims 13, 23, and 24, as well as claims 14-22, 36, and 37 depending from claim 13, and claims 25-35 depending from claim 24. Thus, for at least the reasons discussed above in connection with claim 1, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claims 13-37.

Also, claims 14 and 25 include limitations similar to those discussed above in connection with claim 2. Therefore, the comments presented above in connection with claim 2 apply equally to claims 14 and 25. Thus, for at least the additional

reason discussed above in connection with claim 2, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claims 14 and 25.

Also, claims 15 and 26 include limitations similar to those discussed above in connection with claim 3. Therefore, the comments presented above in connection with claim 3 apply equally to claims 15 and 26. Thus, for at least the additional reason discussed above in connection with claim 3, the proposed combination of Cupps, Hanson, Harrington, and Chui cannot render obvious claims 15 and 26.

The Proposed *Cupps-Hanson-Harrington-Cotter* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 12, 22, and 35

For example, with respect to dependent claim 12, this claim recites:

The system of Claim 1, wherein the broker is further operable to select the particular listed seller automatically according to at least the substantially real-time delivery time information for all of the listed sellers.

Dependent claims 22 and 35 recite similar limitations. *Cupps, Hanson, Harrington, and Cotter*, either individually or in combination, fail to disclose each and every limitation of amended dependent claims 12, 22, and 35.

Claim 12 depends from independent claim 1, claim 22 depends from independent claim 13, and claim 35 depends from independent claim 24. As discussed above, claims 1, 13, and 35 as amended herein are considered patentable over the proposed combination of Cupps, Hanson, Harrington, and Chui at least because this proposed combination fails to disclose or suggest one or more of the databases contain "delivery information associated with each of a plurality of buyers including a maximum delivery time preference of at least one of the plurality of buyers and an indication of how important the delivery time is to the at least one of the plurality of buyers." Cotter likewise fails to disclose or suggest this limitation, so the combined teachings of Cupps, Hanson, Harrington, and Cotter would still fail to disclose or suggest all of the limitations of claims 1, 13, and 24. Since claims 12, 22, and 35 depend from claims 1, 13, and 24, respectively, the proposed combination of Cupps,

Hanson, Harrington, and Cotter would likewise fail to disclose or suggest all the limitations of claims 12, 22, and 35 as well. Since the proposed combination of Cupps, Hanson, Harrington, and Cotter fails to disclose or suggest all of the limitations of claims 12, 22, and 35, the proposed combination cannot render obvious claims 12, 22, and 35.

The Applicant's Claims are Patentable over the Proposed *Parunak-Berkowitz* Combination

As mentioned above, independent claims 1, 13, 23, and 24 are considered patentably distinguishable over *Cupps, Hanson, Harrington, Chui, and Cotter*. With respect to dependent claims 2-12, 14-22, 25-35, 36, and 37: claims 2-12 depend from independent claim 1; claims 14-22, 36, and 37 depend from independent claim 13; and claims 25-35 depend from independent claim 24. As mentioned above, each of independent claims 1, 13, 23, and 24 are considered patentably distinguishable over the proposed combination of *Cupps, Hanson, Harrington, Chui, and Cotter*. Thus, dependent claims 2-12, 14-22, 25-35, 36, and 37 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that claims 1-37 are not rendered obvious by the proposed combination of *Cupps, Hanson, Harrington, Chui, and Cotter*. The Applicant still further respectfully submits that claims 1-37 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1-37 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-37 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, *there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings*. Second, there must be a

reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure***. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed in duplicate concurrently herewith to facilitate the processing of this deposit account authorization. **The Commissioner is hereby authorized to charge the RCE Fee of \$790.00 to Deposit Account No. 500777.** Because this Amendment is filed prior to the ending of the response period 4 July 2006 of the Final Office Action mailed on 4 April 2006, no additional fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayments, to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

6/23/06

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